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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,733	03/16/2004	Kazuto Yamamoto	011350-328	1040
21839 7590 07/09/2008 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404				
EXAMINER				
WILLS, LAWRENCE E				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
07/09/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/800,733

Applicant(s)

YAMAMOTO ET AL.

Examiner

LAWRENCE E. WILLS

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38, 41, 42, 46, 49, 50, 54, 57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38, 41-42, 46, 49-50, 54, 57-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 35-37, 39, 40, 43-45, 47, 48, 51-53, 5, and 56 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on March 6, 2008.

Response to Arguments

2. Applicant's arguments filed March 6, 2008 have been fully considered but they are not persuasive. Group I is drawn to a judging unit to determine if a document has a tag, transporting unit moving the document, a display unit for sending a message to a user when a document is tagged, and a selecting unit for selecting whether the image data should be printed or not. These limitations would require a different search from Group II which is drawn to a display unit for displaying modifiable attribute information, modifying unit for modifying attribute information, and writing unit for writing data on the tag.

Applicant's arguments, see page 13-14, filed November 13, 2007, with respect to the rejection(s) of claim(s) 38, 46, and 54 under U.S.C. 102 (a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Yano (US Pub. No. 2004/0109194). Yano'194 teaches a reading unit (number 520, Fig. 8) for reading out modifiable attribute information (additional information, paragraph 0102-0110) among attribute information of said electronically tagged printed matter from said electronic tag (data from IC chip, paragraph 0106); a display unit (number 26, Fig. 4) for displaying the modifiable attribute information read out by said second

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reading unit (Fig. 10/11); a modifying unit (number 510, Fig. 8 user interface) for modifying the modifiable attribute information read out by said second reading unit (user operation designating an output format, paragraph 104); and a printing unit (number 560, Fig. 8) for printing image data read by said reading unit, based on the attribute information modified by said modifying unit (S110, Fig. 9).

Having a system of Teraura'279 reference and then given the well-established teaching of Yano'194 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the RFID read/write MFP system of Teraura'279 reference to include means for controlling additional information as taught by Yano'194 reference. The combination would have increased the flexibility of the MFP system, further, the control of additional information would have yielded predictable results when applied to the MFP system.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 38, 41, 42, 46, 49, 50, 54, 57, 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura (US Patent 6,827,279) in view of Yano (US Pub. No. 2004/0109194).

Regarding claims 38, 46, and 54 Teraura'279 teaches an image forming device (number 1, Fig. 5), comprising: a reading unit (number 15, Fig. 5) for reading image data from an electronic tag of an electronically tagged printed matter (Step B5, Fig. 7) wherein image data is printed (Step A5, Fig. 6) on an electronically tagged printing paper equipped with the electronic tag (Fig. 1) for storing electronic data in a certain part of the printing paper (Step A4, Fig. 6) and said electronic tag stores image data printed on said electronically tagged printing paper (B14 and B15, Fig. 8); and a second reading unit (number 16, Fig. 5).

Teraura'279 fails to teach a reading unit for reading out modifiable attribute information among attribute information of said electronically tagged printed matter from said electronic tag; a display unit for displaying the modifiable attribute information read out by said second reading unit; a modifying unit for modifying the modifiable attribute information read out by said second reading unit; and a printing unit for printing image data read by said reading unit, based on the attribute information modified by said modifying unit.

Yano'194 teaches a reading unit (number 520, Fig. 8) for reading out modifiable attribute information (additional information, paragraph 0102-0110) among attribute information of said electronically tagged printed matter from said electronic tag (data from IC chip, paragraph 0106); a display unit (number 26, Fig. 4) for displaying the modifiable attribute information read out by said second reading unit (Fig. 10/11); a modifying unit (number 510, Fig. 8 user interface) for modifying the modifiable attribute information read out by said second reading unit (user operation designating an output format, paragraph 104); and a printing unit (number 560, Fig. 8) for printing image data read by said reading unit, based on the attribute information modified by said modifying unit (S110, Fig. 9).

Having a system of Teraura'279 reference and then given the well-established teaching of Yano'194 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the RFID read/write MFP system of Teraura'279 reference to include means for controlling additional information as taught by Yano'194 reference. The combination would have increased the flexibility of the MFP system, further, the control of additional information would have yielded predictable results when applied to the MFP system.

Regarding claims 41, 49, and 57 the combination of Teraura'279 and Yano'194 teach wherein said printing unit (Teraura'279, number 11, Fig. 5) prints image data on an electronically tagged printing paper equipped with an electronic tag for storing electronic data in a certain part of the printing paper (Teraura'279, Fig. 1), further comprising: a writing unit (Teraura'279, number 17, Fig. 5) for writing the image data printed by said printing unit on the electronic tag of the electronically tagged printing paper on which the image data is printed by said printing unit (Teraura'279, Step A4, Fig. 6).

Regarding claims 42, 50 and 58 the combination of Teraura'279 and Yano'194 teach wherein said electronic tag transmits or receives electronic data by means of wireless communications (Teraura'279, radio wave signals, column 4, lines 48-53).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAWRENCE E. WILLS whose telephone number is (571)270-3145. The examiner can normally be reached on Monday-Friday 9:30 AM - 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

LEW
June 23, 2008